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Adam J. Weissman

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PATENT DEPARTMENT - 53051  
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EXAMINER

ROSE, HELENE ROBERTA

ART UNIT

PAPER NUMBER

2163

DATE MAILED: 12/07/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

|                              |                                      |  |  |
|------------------------------|--------------------------------------|--|--|
| <b>Office Action Summary</b> | <b>Application No.</b><br>10/689,903 | <b>Applicant(s)</b><br>WEISSMAN ET AL. |  |
|                              | <b>Examiner</b><br>Helene Rose       | <b>Art Unit</b><br>2163                |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 26 September 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-35 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-35 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 21 October 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 5/13/06, 5/3/05, 8/8/06, 9/11/06, 11/26/04
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

### **Detailed Action**

1. This office action is in response to an AMENDMENT entered on 9/15/2006 for patent application 10/689,903 filed on 10/21/2003
2. In response to communications entered on 9/15/2006, Claims 1-35 are pending. Claim 29 was amended. No claims were added, nor cancelled.
3. Applicant's arguments filed in response to claims 1-35 have been fully considered but they are not persuasive.

### **Information Disclosure Statement**

4. The information disclosure statement (IDS) submitted on 11/26/04, 5/3/2005 and 5/13/2006; accordingly, the information disclosure statement is still being considered by the examiner.

The information disclosure statement (IDS) submitted on 8/8/2006 and 9/11/2006 was filed after the mailing date of the application on 10/21/2003. The submission is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner.

### **Specification**

5. In view of the abstract being objected to because it was missing the title of the invention, the Examiner withdraws the pending objection.

### **Claim Rejection – 35 U.S.C - 101**

6. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

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7. Claims 1- 35 are rejected under 35 U.S.C. 101 because the claimed invention lacks patentable utility; the following claims does not produce a specific, nor substantial “useful” result. In regards to this matter please see (MPEP § 2107 and Fisher, 421 F.3d at \_\_,76 USPQ2d, wherein it cites the Utility Guidelines with the approval for interpretation of “specific” and substantial”).

In addition to the above matter, claim 14, the applicant discloses a computer readable medium for receiving the method disclosed in claims 1 and 3, but does not defined wherein accessing, identifying, and determining utilizing a program code, is disclosed on a practical utility.

According to the Revised Guidelines, which states that “a claim limited to a machine or manufacture”, which has a practical application, is considered to be a practical utility.

#### **Claim Rejections – 35 U.S.C – 102**

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

9, Claims 1-35 are rejected under 35 U.S.C. 102(e) as being anticipated by Chipalkatti et al (US Patent No. 6,484,161, Filing Date of Patent: March 31, 1999).

Claims 1, 14 and 28:

Claims 1, 14 and 28 discloses a method/computer readable medium utilizing the same functionality, wherein Chipalkatti discloses a method/computer readable medium, comprising:

accessing a source article (column 5, lines 58-61, Chipalkatti);  
identifying a plurality of regions in the source article (column 5, lines 58-67, Chipalkatti);  
determining at least one local concept associated with each region (column 40, lines 56-63);  
analyzing the local concepts of each region to identify any unrelated regions (column 34, lines 43-57, Chipalkatti);  
eliminating the local concepts associated with any unrelated regions to determine relevant concepts (column 35, lines 1-10);  
analyzing the relevant concepts to determine a source meaning for the source article (column 35, lines 25-37, Chipalkatti); and  
matching the source meaning with an item meaning associated with an item from a set of items (column 37, lines 2-19, Chipalkatti).

Claims 2, 15 and 29:

Regarding claims 2, 15 and 29, Chipalkatti teaches displaying the matched item **associated with** the source article (Figure 44, all features).

Claims 3, 16 and 32:

Regarding claims 3, 16 and 32, Chipalkatti teaches wherein the source article is a web page and the matched item is a keyword (Figure 11, all features).

Claims 4, 17 and 31:

Regarding claims 4, 17 and 31, Chipalkatti teaches wherein the source article is a web page and the matched item is an advertisement (Figure 15, all features, wherein its further defined in column 10, lines 32-37, Chipalkatti).

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Claims 5 and 18:

Regarding claims 5 and 18, Chipalkatti teaches displaying content associated with the matched item on the source article (column 10, lines 53-57, Chipalkatti).

Claims 6, 19 and 35:

Regarding claims 6, 19 and 35, Chipalkatti teaches wherein the source article is a web page, the matched item is a keyword and the associated content is an advertisement (Figure 39, all features, wherein its further defined in columns 32-33, lines 45-67 and lines 12-17, Chipalkatti).

Claims 7 and 20:

Regarding claims 7 and 20, Chipalkatti teaches wherein the source article is a first web page, the matched item is a second web page and the associated content is an advertisement (column 37, lines 3-16, Chipalkatti).

Claims 8 and 21:

Regarding claims 8 and 21, Chipalkatti teaches wherein the source article is a first web page, the matched item is a second web page and the associated content is a link to the second web page Figures 14 and 15, all features, wherein shoes –custom made, i.e. diagram 1862 is selected in first page and wherein Figure 15, equivalent to second web page, wherein listing are illustrated).

Claims 9 and 22:

Regarding claims 9 and 22, Chipalkatti teaches wherein matching the source meaning with an item meaning comprises using biasing factors (columns 26-27, lines 65-67 and lines 1-17, Chipalkatti).

Claims 10 and 23:

Regarding claims 10 and 23, Chipalkatti teaches the source meaning is a vector of weighted concepts (column 25, lines 1-7, wherein the weight is define within table and column 34, lines 19-28).

Claims 11 and 25:

Regarding claims 11 and 25, Chipalkatti teaches wherein determining at least one local concept comprises determining a score for each local concept, wherein the local concept in each region with the highest scores are most relevant local concepts (column 30, lines 8-16, Chipalkatti).

Claims 12 and 26:

Regarding claims 12 and 26, Chipalkatti teaches wherein identifying unrelated regions comprises determining a revised score for each local concept (columns 40-41, lines 64-67 and lines 1-17, Chipalkatti), determining a ranked global list of all local concepts based on the revised scores (column 26, lines 50-52), removing local concepts whose combined revised score contributes less than a predetermined amount of a total score for the global list to produce a resulting list (Figure 4, diagram 834, wherein its further defined in column 7, lines 1-11, Chipalkatti), determining unrelated regions with no most relevant local concepts on the resulting list (REFER to claim 1, wherein this limitation has already been addressed, Chipalkatti), and removing local concepts associated with the unrelated regions from the resulting list to produce a list of relevant concepts (REFER to claim 1, wherein this limitation has already been addressed, Chipalkatti).

Claims 13 and 27:

Regarding claims 13 and 27, Chipalkatti teaches wherein determining a source meaning comprises normalizing the revised scores for the relevant concepts (Figure 25, diagram 900, wherein

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normalized data is illustrated and further defined in column 13, lines 57-60 and columns 40-41, lines 64-67 and lines 1-17, Chipalkatti).

Claim 24:

Regarding claim 24, Chipalkatti teaches wherein program code for analyzing the relevant local concepts comprises program code for ranking the relevant local concepts (column 26, lines 50-52 and column 49, lines 50-52, wherein program code is defined to be JAVA, Chipalkatti).

Claims 30 and 34:

Regarding claims 30 and 34, Chipalkatti teaches wherein the first item is displayed in the first content region and the second item is displayed in the second content region (column 24, lines 31-47, wherein the first request results in a query and the second request results in a query, wherein the second request is performed quickly by using the data query cache information and searching for a subset of the cached data indicated the restaurants, Chipalkatti).

Claim 33:

Regarding claim 33, Chipalkatti teaches displaying first content associated with the first item and displaying second content associated with the second item on the source article (Figures 11 and 12, all features, wherein the first item is interpreted to be restaurants associated with items listed within Figure 12 in which its is linked to the source article, i.e. next web page which displays all the eatery places, Chipalkatti).



### Response to Arguments

#### In reference to the Applicant's arguments:

This Amendment is a full and timely response to the Office Action dated June 15, 2006.

Claims 1-35 are pending in the application. Claims 1-35 have been rejected. Claim 29 has been amended. No new matter is added, and support for the amendment may be found throughout the specification and in the original claims. Upon entry of the present amendment, claims 1-35 will be pending in this application.

In the June 15, 2005 Office Action, the Examiner rejected all pending claims 1-35. The Applicants respectfully traverse the Examiner's rejections. For the reasons set forth below, the Applicants submit that the rejections should be withdrawn and that the claims are in condition for allowance.

#### Claim Rejections - 35 U.S.C. § 101

The Office Action rejected claims 1-35 under 35 U.S.C. § 101 as being allegedly lacking patentable utility. The Examiner states that the claims are directed to non-statutory subject matter, because the claims do not "produce a specific, nor substantial useful result" The Examiner notes that "[i]n order to overcome this rejection, applicant must include a final result of the present invention that will convey a concrete, useful, and practical utility as it relates to the claimed invention." The Applicants do not agree with the Examiner's characterization of the claims and the rejection of the claims under 35 U.S.C. § 101 and respectfully traverse this rejection. Utility under 35 U.S.C. § 101 is found if the claimed invention produces a useful, concrete, and tangible result. See Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility, Official Gazette Notices, 22 November 2005, <http://www.uspto.gov/web/offices/eom/sol/og/2005/weeka7/patguoa.hma> (hereinafter Interim Guidelines).

Claims 1-35 do produce a useful, concrete, and tangible result and, therefore, do meet the patentability requirement set out by § 101. The Federal Circuit has held that for a claimed invention to satisfy the requirements of 35 U.S.C. § 101, it must produce a "useful, concrete, and tangible result." *State St. Bank & Tr. Co. v. Signature Fin. Group, Inc.*, 149 F.3d 1368, 1373-74 (Fed. Cir. 1998). In its Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility, the USPTO states that the Examiner should weigh the aforementioned factors to determine whether 35 U.S.C. § 101 is met. See Interim Guidelines. Because the Applicants' invention meets each of the three factors, as explained below, claims 1-35 are patentable under 35 U.S.C. § 101.

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## A. Useful

First, the Applicants' claimed invention is useful. For this criterion to be met, the Patent Office requires a claimed invention's utility to be "specific, substantial, and credible." See M.P.E.P. § 2107(II)(A)(3); Interim Guidelines. The M.P.E.P. describes a "specific and substantial utility" as excluding "throw-away," "insubstantial," and "nonspecific" utilities. § 2107(I)(B)(1)(i). The Applicants' claimed invention cannot be categorized as any of these three types of exclusions. Rather, it has the specific utility of determining the meaning of an article, such as a web page, or determining a concept associated with a region in the article and matching that meaning or concept with an item, such as a keyword or an advertisement. The claimed invention is useful, for example, because items, such as advertisements or keywords may be matched to articles, such as Web pages, or a region of the article. Therefore, the Applicants' claimed invention is useful, because it has a specific and substantial utility.

## B. Concrete

Second, the Applicants' claimed invention is concrete. For this factor to be met "the process must have a result that can be substantially repeatable or the process must substantially produce the same result again." Interim Guideline]. The Applicants' claimed invention meets this criterion, because an item, such as a keyword or advertisement is matched with a meaning associated with an article or a concept associated with a region of an article. When these methods are embodied and followed, the process of matching items with meaning of an article or a region of the article is repeatable. Therefore, the Applicants' claimed invention is concrete, because it produces a result that is substantially repeatable.

## C. Tangible

Third, the Applicants' claimed invention is tangible. This requirement "does not necessarily mean that a claim must either be tied in a particular machine or apparatus or must operate to change articles or materials to a different state or thing." Interim Guidelines. Rather, the claim must set out a "practical application" that produces a "real-world result" Id. The Applicants' claimed invention sets out a practical application in claims 1, 14, and 28 (and, thus, to their respective dependent claims) by matching an item, such as a keyword or advertisement, with the meaning of an article, such as a web page, or a concept associated with a region of the article. By this matching, an advertisement can be selected and displayed associated with the article or region of the article. Thus, because the Applicants' claimed invention has a practical application and produces real-world results, claimed invention is tangible. Therefore, because each of three criteria for patentability under § 101 are met, the Office Action rejection to those claims is believed to be traversed, and claims 1-35 are in condition for allowance.

**Examiner Response:**

The invention must be clearly stated to identify its usefulness, wherein applicant fails to disclose enough information about the invention to make its usefulness immediately apparent to those familiar with the technological field of the invention. *Brenner v. Manson*, 383 U.S. 519, 148 USPQ 689 (1966); > *In re Fisher*, 421 F.3d 1365, 76 USPQ2d 1225 (Fed. Cir. 2005); < *In re Ziegler*, 992 F.2d 1197, 26 USPQ2d 1600 (Fed. Cir. 1993). Therefore, the rejection still stands.

**In reference to the Applicant argument:**

Claim Rejections – 35 U.S.C – 102

Chipalkatti relates to a system for performing online data queries. Specifically, Chipalkatti discloses a system for performing search queries for information contained in "yellow pages," such as the GTE Superpages. Chipalkatti, 5:1-24, 5:55-67. **The Examiner states that Chipalkatti discloses "identifying a plurality of regions in the source article" at col. 5, lines 58-61. This section of Chipalkatti does not so disclose.** Rather, it discloses that the GTE Superpages Interact site contains a variety of information that can be searched by a user.

Further, the Examiner states that Chipalkatti discloses **"analyzing local concepts associated with any unrelated regions to determine relevant concepts" at col. 35, lines 43-57. This section of Chipalkatti does not so disclose.** Rather, it discloses determining categories into which retrieved documents relevant to a user's search query fall. Moreover, this section discloses comparing categories from the retrieved documents to the user's search query to determine if any categories are not relevant to the search query.

**Examiner Response:**

"Identifying a plurality of regions in the source article", Refer to column 5, lines 48-54, wherein initial screen that may be displayed to a user entering a URL corresponding to the GTE Superpages Internet site, which is interpreted to be a source article, wherein a source article is defined by applicant in claim 2, to be a web page, which includes fields of query information, hyperlinks to other tools such as online shopping or placing advertisements, and other links, which is interpreted to be the plurality of regions, wherein the GTE Superpages Internet site is related to

online yellow pages similar to those included in a paper phone book, wherein with these online yellow pages various business services and user services may be provided, and wherein the plurality of regions is interpreted to be business services and so forth, Chipalkatti.

“Analyzing local concepts associated with any unrelated regions to determine relevant concepts”, Refer to column 34, lines 34-50, wherein the categories are yellow pages categories, which have been previously assigned to the documents, which are business listings, prior to entry of the business listings in the Primary Database and the information retrieval software determines what categories are associated with the business listings retrieved by the ranking and the information retrieval software may compare the categories identified to the terms in the user query and if categories are present that do not include any of the terms in the user query, then such categories may be discarded, and the user will not retrieve categories that are unrelated to the user query, and wherein Such categories might otherwise appear, wherein for example, and wherein if the information retrieval software retrieves a business listing that is associated with two unrelated categories, only one of which is relevant to the user query; which is interpreted to be analyzing local concepts with any unrelated regions to determine relevant concepts, Chipalkatti.

**In reference to the Applicant argument:**

The Examiner also states that Chipalkatti discloses "**eliminating the local concepts associated with any unrelated regions to determine the relevant concepts**" at col. 35, lines 1-10. **This section of Chipalkatti does not so disclose.** Rather, it discloses determining whether the documents or business listings retrieved are associated with more than one category. If the business listing retrieved are associated with a single category, then the business listings may be displayed. If the business listings retrieved are associated with more than one category, then the list of categories may be displayed.

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**Examiner Response:**

“Eliminating the local concepts associated with any unrelated regions to determine the relevant concepts”, Refer to columns 34-35, lines 62-67 and lines 1-10, wherein once the non-matching categories are discarded, the information retrieval software may, determine whether there are any remaining categories and If not, then control proceeds, at which the user is informed that there are no matching categories and the user may then be returned to the query screen and if, at least one category remains, then, the information retrieval software determines whether there is more than one category and If not, then the system may display the actual business listings that appear in that one category to the user and if it is determined that more than one category remains, then the system may display a results page that consists of a list of the remaining categories, wherein the results page may further include an indication of the number of listings that are associated with each category, wherein this is interpreted to be eliminating the local concepts associated with any unrelated regions to determine the relevant concepts, Chipalkatti.

**In reference to the Applicant argument:**

Additionally, the Examiner states that Chipalkatti discloses **analyzing the relevant concepts to determine a source meaning for the source article"** at col. 35, lines 25-37. **This section of Chipalkatti does not so disclose.** Rather, it discloses pre-processing steps for classifying and establishing query result sets for common search queries by designing common terms. Although not specifically discussed by the Examiner, Chipalkatti further discloses a system for targeting banner advertisements based on a user's search query that are displayed to a user of the system. See. e.g., 61:26-64:21. However, Chipalkatti discloses matching advertisements to a user's search query and **does not disclose, inter alia, matching a meaning of a source article with an item meaning associated with an item, such as a keyword or advertisement, as claimed in the present invention.**

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**Examiner Response:**

“Analyzing the relevant concepts to determine meaning for the source article”, Refer to column 35, lines 21-50, wherein a series of steps may be performed as pre-processing operations in order to classify and establish query result sets for common queries, wherein common terms may be identified prior to system initialization, and so forth, and wherein alternatively, common terms might consist of multiple word combinations of any length, whether bi-grams, tri-grams, or n-grams. Thus, words that co-occur in high frequency can be designated as common terms, such as in a bi-gram format. For example, the bi-gram "Boston--restaurant" might be designated a common term, wherein terms may be linked to specific contexts designated or classified as common terms in part according to their context, and so forth, and the common term sets may be structured to reflect context, wherein the bi-gram "Boston--Restaurant" might be stored as an expanded form that reflects both the term and the context in which it is to be treated as a common term, for example "City =Boston; Category =Restaurant.", which is equivalent to determining the meaning for the source article, Chipalkatti.

“Matching a meaning of a source article with an item meaning associated with an item, such as keyword or advertisement”, Refer to column 37, lines 3-17, wherein set of matching categories for the query and so forth, Chipalkatti.

### **Prior Art of Record**

(The prior art made of record and not relied upon is considered pertinent to applicant's disclosure)

1. Chipalkatti et al (US Patent No. 6,484,161) discloses a system for performing online data queries.
2. Wesinger, Jr. et al. (US Patent No. 6,324,538) discloses computer network and a database are used to provide a hardware-independent, dynamic information system in which the information content is entirely user-controlled.

### **Conclusion**

Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

### **Point of Contact**

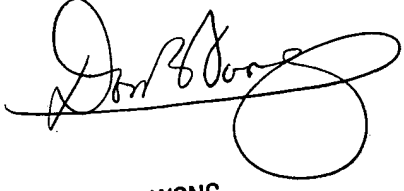
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Helene Rose whose telephone number is (571) 272-0749. The examiner can normally be reached on 8:00am - 4:30pm Monday-Friday.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Don Wong can be reached on (571) 272-1834. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Helene Rose  
Technology Center 2100  
November 30, 2006



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